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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,393	08/01/2003	Brian McKeown	13428-US	2918
23719	7590	08/28/2006		
KALOW & SPRINGUT LLP 488 MADISON AVENUE 19TH FLOOR NEW YORK, NY 10022				
			EXAMINER WHALEY, PABLO S	
			ART UNIT 1631	PAPER NUMBER

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/632,393

Applicant(s)

MCKEOWN ET AL.

Examiner

Pablo Whaley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 1-50 and 53-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51, 52, and 62-68 is/are rejected.
- 7) ☒ Claim(s) 51, 63 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/21/2005.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *CLAIMS UNDER EXAMINATION*

Claims herein under examination are claims 51, 52, and 62-68. Claims 62-68 are newly added. This application contains claims 1-50 and 53-61 drawn to an invention nonelected with traverse in the response filed 12/28/2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied, as necessitated by amendment. They constitute the complete set presently being applied to the instant application.

### *IDS*

The information disclosure statement filed 10/21/2005 has been considered in full.

### *OBJECTIONS*

Claim 51 is objected to because of the following informalities: Claim 51 is grammatically incorrect, and should recite "comparing the extension product...with the extension product..." in lines 22 and 23. Appropriate correction is required.

Claim 63 is grammatically incorrect, and should recite "second 5' tag differ by." Appropriate correction is required.

Claim 52 is objected to for having incorrect status. It is listed as "original" when in fact, it is "amended". Correction is requested.

### **CLAIM REJECTIONS - 35 USC § 112, 2<sup>nd</sup> Paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51, 52, and 62-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claim 51 recites the limitation “bases in sequence as at least the variant nucleotide.” It is unclear in what way “as at least” further limits the method. Clarification is requested.

Amended claim 51 recites the limitations “primer employed” (line 6) and “employing a second strand...primer” (line 10). In both cases, it is unclear in what way the said primer is being employed. Furthermore, it is unclear if this is a physical method step or a limitation of the method. Clarification is requested.

Amended claim 51 recites the limitations “comparing extension product...., thereby performing the primer extension reaction” (lines 23-24). It is unclear in what way said comparing step results in a primer extension reaction. Clarification is requested.

Amended claim 52 recites the limitation “target can be.” It is unclear whether the term “can be” is a positive limitation of the method, an optional step of the method, or otherwise. Clarification is requested.

Amended claim 52 recites the limitation “each first strand amplification primer..., the first 5' tag...comprises the same nucleotide base...”. It is unclear in what way this limitation further limits the method of parent claim 52. Clarification is requested.

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Amended claim 52 recites the limitation "primers are employed" (line 4). It is unclear in what way the said primer is being employed. Furthermore, it is unclear if this is a physical method step or a limitation of the method. Clarification is requested.

Amended claim 52 recites the limitation "known ratios." It is unclear whether "known ratios" is referring to sequences, the first 5' tag, the second 5' tag, or otherwise. Clarification is requested. Claims 62-68 are rejected as they depend directly or indirectly from claims 51 and 52. This rejection is necessitated by amendment.

### **Provisional Double Patenting Rejection**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 51, 52, 62-64, and 66-68 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 51, 52, 53, 10, 16, 17, and 18, filed 06/15/2006, of co-pending Application No. 10/328,150. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. This rejection is necessitated by

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amendment.

### **CONCLUSION**

No Claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Whaley whose telephone number is (571)272-4425. The examiner can normally be reached on 9:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached at 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pablo S. Whaley

Patent Examiner  
Art Unit 1631  
Office: 571-272-4425



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